

PATENT APPLICATION
Attorney Docket No.: TRV03-0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF)	
Dennis R. Berman)	Examiner: Gishnock, Nikolai A.
Application No.: 10/613,564)	Group Art Unit: 3714
Filing Date: July 02, 2003)	Confirmation Number: 5486
Title: METHOD AND SYSTEM FOR LEARNING)	
KEYWORD BASED MATERIALS)	

SUBMITTAL OF MATERIALS FROM CO-PENDING APPLICATIONS

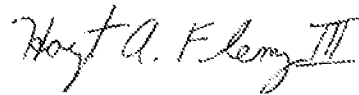
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Recently, the Federal Circuit, in *McKesson Information Solutions, Inc., v. Bridge Medical, Inc.* (2005-1517) affirmed a District Court's determination that a patent was unenforceable due to inequitable conduct. The inequitable conduct was based upon a patent attorney's nondisclosure of office actions from co-pending applications.

In light of *McKesson*, I have attached an office action from a co-pending application of the present application. You may or may not find this office action to be material to the present application.

Respectfully submitted,



Hoyt A. Fleming III
Registration No. 41752

Date: August 11, 2008

Address correspondence to: <input checked="" type="checkbox"/> <i>Customer Number or Bar Code Label</i> 28422	or <input type="checkbox"/> <i>Correspondence Address Below</i> Park, Vaughan & Fleming LLP P.O. Box 140678 Boise, ID 83714	Direct telephone calls to: Hoyt A. Fleming III (208) 336-5237
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/156,286

06/17/2005

Dennis R. Berman

TRV03-0001-4

5371

28422

7590

07/24/2008

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EXAMINER

EGLOFF, PETER RICHARD

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

07/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 11/156,286	Applicant(s) BERMAN, DENNIS R.	
	Examiner PETER R. EGLOFF	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/17/05, 7/22/05, 11/04/05, 7/24/06, 12/11/06,</u> | 6) <input type="checkbox"/> Other: ____. |
| <u>6/22/07, 8/23/07, 1/11/08, 4/22/08.</u> | |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 13 are directed to training methods performed by a computer. The only step of the claim(s) is directed to the act of “displaying on a computer screen” several pieces of information. In order to be statutory a claimed method must produce a useful, concrete and tangible result. The individual step of displaying information, without being tied to any other performed functions, is deemed to be non-tangible as it amounts merely to an abstract idea of placing data on a computer screen. Claims 2-12 and 14-20 are rejected for inheriting the deficiencies of their respective parent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 13 are rejected under 35 U.S.C. 112 because the preamble of the claims recite a training method, yet the body of the claims only recite steps of displaying. It is unclear how merely displaying information is capable of performing the intended function of training.

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Claims 2-12 and 14-20 are rejected for inheriting the deficiencies of their respective parent claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerwin (US 2001/0036619 A1).

Regarding claim 1, Kerwin discloses in Fig. 7a a training method performed by a computer, the method comprising: displaying on a computer screen a question (Who is Dick Burford?), a correct answer to the question (Dick is the Accounting Manager), and an incorrect answer to the question (Dick is the Production Manager); the correct answer to the question containing a first word that is not a keyword (Manager); the incorrect answer to the question containing the first word (Manager); the correct answer including a second word that is a keyword (Accounting); the second word being included in a first selection object (answer choice) that is selectable by the user; the incorrect answer including a third word that is a keyword (Production); the third word being included in a second selection object that is selectable by the user (see par. 69).

Regarding claim 3, Kerwin further discloses the first selection object is selectable using a mouse (Figure 1, element 19).

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Regarding claim 6, Kerwin further discloses the user is not allowed to continue training until the user selects the first selection object (see Par. 38).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1).

Regarding claim 5, Kerwin does not explicitly disclose the first selection object is centered horizontally with respect to the second selection object. Instead, Kerwin discloses the answer choices are left justified (see Fig. 7a). At the time the invention was made, however, it would have been an obvious matter of design choice to a person of ordinary skill in the art to center the selection objects, because applicant has not disclosed doing so provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kerwin's

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format, and applicant's format, to perform equally well, because both would perform the same function of presenting the answer choices to the user. Therefore, it would have been prima facie obvious to modify the teachings of Kerwin by centering the first selection object with respect to the second selection object, which would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kerwin.

10. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Nathanson (US Patent No. 5,618,180).

Regarding claims 2 and 4, Kerwin does not explicitly disclose the first selection object is selectable using a touch screen (as per claim 2) or a trackball (as per claim 4), however Nathanson discloses a computer training apparatus that allows users to use a trackball or touch screen to make selections (column 8, lines 1-5). It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by using a trackball or touch screen, as disclosed by Nathanson, with the motivation of accommodating users who prefer other types of input devices.

11. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Parry et al. (US Patent No. 6,077,085).

Regarding claim 7, Kerwin does not explicitly disclose the appearance of the second selection object is modified if the second selection object is selected and the modification indicates that the third word in the second selection object is a part of the incorrect answer to the question. However, Kerwin does disclose displaying to the user

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why an answer was incorrect, which would naturally involve explaining that the third word is a part of the incorrect answer to the question (explaining that the choice containing the word "Production" is incorrect, because Dick is not the Production Manager). Further, Parry discloses a computer training device that includes the feature of changing the appearance of an incorrect answer (highlighting discrepancies in his/her answer) to illustrate why an answer was incorrect. It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the feature of highlighting discrepancies in an incorrect answer, as taught by Parry, with the motivation of quickly displaying to the user why the chosen answer was incorrect.

Regarding claim 9, Kerwin does not explicitly disclose displaying a "Hint" object, however Parry discloses displaying a hint (column 3, lines 67 - column 4, line 5). It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the hint taught by Parry, with the motivation of assisting the user in identifying the correct answer.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Lee et al. (US Patent No. 4,968,255).

Regarding claim 8, Kerwin does not explicitly disclose a sound is generated if the second selection object is selected and the sound indicates that the third word in the second selection object is a part of the incorrect answer to the question. As stated in the rejection of claim 7, Kerwin does disclose explaining that the third word in the second selection object is a part of the incorrect answer. Further, Lee discloses an instructional apparatus with the feature of producing an audible presentation indicating an incorrect

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response. It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the audible response taught by Lee, to create an audible response as to why the third word is a part of the incorrect answer, with the motivation of allowing the user to hear the visual feedback.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Kitabatake.

Regarding claim 11, Kerwin does not explicitly disclose the first selection object includes no displayed text that is not a keyword, however Kitabatake discloses a multiple choice question that where the selection objects do not include displayed text that is not a keyword (see Fig. 73(b)). It would have been obvious to one skilled in the art to modify the teachings of Kerwin by using answer choices that do not include non-keywords, with the motivation of making the answer choices less confusing to the user.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Parry et al. (US Patent No. 6,077,085), and further in view of Newsom et al. (US 2003/0232312 A1).

Regarding claim 10, Kerwin and Parry do not explicitly disclose if the "Hint" object is selected by the user, then the appearance of the first selection object is modified, however Newsom discloses a hint involving highlighting a correct answer, thereby changing its appearance (see Par. 44). It would have been obvious to one skilled in the art to modify the teachings of the combination of Kerwin and Parry by using the highlighting

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hint taught by Newsom, with the motivation of quickly displaying to the user the correct answer.

15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Heffernen, III et al. (US Patent No. 6,634,887 B1).

Regarding claim 12, Kerwin does not explicitly disclose the correct answer and the incorrect answer include a keyword that was previously selected by the user, however Heffernen discloses a computer training system with the feature of providing a follow-up question that contains a previously selected keyword (multiplication) (column 3, lines 25-31). It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the feature of having a question contain a keyword from a previous question, with the motivation of linking a subsequent question to the previous question.

16. Claims 13, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Newsom (US 2003/0232312 A1).

Regarding claim 13, Kerwin discloses a training method performed by a computer, the method comprising: displaying on a computer screen a question (Who is Dick Burford?), a first selection object and a second selection object (answer choices); the first selection object, which is selectable by a user, includes a correct answer to the question (Dick is the Accounting Manager); the correct answer to the question includes a first word that is not a keyword (Manager) and a second word that is a keyword

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(Accounting); the second selection object, which is selectable by a user, includes an incorrect answer to the question (Dick is the Production Manager); the incorrect answer to the question includes a third word that is not a keyword (Dick) and a fourth word that is a keyword (Production). Kerwin does not explicitly disclose the words that are not keywords being in a first font, and the keywords in a second font, however Newsom discloses the feature of italicizing a portion of an answer to place emphasis on the portion (see Par. 44). It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by changing the font of a portion of the answer, as taught by Newsom, with the motivation of providing a hint to the user.

Regarding claim 15, Kerwin further discloses the first selection object is selectable using a mouse (Figure 1, element 19).

Regarding claim 17, Kerwin does not explicitly disclose the first selection object is centered horizontally with respect to the second selection object. Instead, Kerwin discloses the answer choices are left justified (see Fig. 7a). At the time the invention was made, however, it would have been an obvious matter of design choice to a person of ordinary skill in the art to center the selection objects, because applicant has not disclosed doing so provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kerwin's format, and applicant's format, to perform equally well, because both would perform the same function of presenting the answer choices to the user. Therefore, it would have been prima facie obvious to modify the teachings of Kerwin by centering the first selection object with respect to the second selection object, which would have been considered a

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mere design consideration which fails to patentably distinguish over the prior art of Kerwin.

Regarding claim 18, Kerwin further discloses the user is not allowed to continue training until the user selects the first selection object (see Par. 38).

17. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Newsom (US 2003/0232312 A1), and further in view of Nathanson (US Patent No. 5,618,180).

Regarding claims 14 and 16, Kerwin and Newsom do not explicitly disclose the first selection object is selectable using a touch screen (as per claim 14) or a trackball (as per claim 16), however Nathanson discloses a computer training apparatus that allows users to use a trackball or touch screen to make selections (column 8, lines 1-5). It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin and Newsom by using a trackball or touch screen, as disclosed by Nathanson, with the motivation of accommodating users who prefer other types of input devices.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Newsom (US 2003/0232312 A1), and further in view of Parry et al. (US Patent No. 6,077,085).

Regarding claim 19, Kerwin and Newsom do not explicitly disclose the appearance of the second selection object is modified if the second selection object is selected and the modification indicates that the second selection object is the incorrect

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answer to the question. However, Kerwin does disclose displaying to the user why an answer was incorrect, and Parry discloses a computer training device that includes the feature of changing the appearance of an incorrect answer (highlighting discrepancies in his/her answer) to illustrate why an answer was incorrect. It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the feature of highlighting discrepancies in an incorrect answer, as taught by Parry, with the motivation of quickly displaying to the user why the chosen answer was incorrect.

19. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 2001/0036619 A1) in view of Newsom (US 2003/0232312 A1), and further in view of Lee et al. (US Patent No. 4,968,255).

Regarding claim 20, Kerwin and Newsom do not explicitly disclose a sound is generated if the second selection object is selected and the sound indicates that the third word in the second selection object is a part of the incorrect answer to the question. As stated in the rejection of claim 7, Kerwin does disclose explaining that the third word in the second selection object is a part of the incorrect answer. Further, Lee discloses an instructional apparatus with the feature of producing an audible presentation indicating an incorrect response. It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Kerwin by adding the audible response taught by Lee, to create an audible response as to why the third word is a part of the incorrect answer, with the motivation of allowing the user to hear the visual feedback.

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Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Egloff whose telephone number is (571) 270-3548. The examiner can normally be reached on M-F 7:30am - 5:00 pm EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached at (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3714

Peter Egloff
7/17/08